

### Remarks

Claims 34-40 have been amended such that they now depend from pending independent claim 33. No new matter is added with this amendment. Withdrawal of the rejection under 35 U.S.C. § 112, second paragraph is respectfully requested.

Claims 33-40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hedge, Bloor or Podolak. The cited prior art references disclose various saponins. Saponins are, generally, steroid or triterpenoid glycosides (see the specification at page 2, second full paragraph). In other words, to be a saponin, a compound requires a steroid or triterpenoid portion, and a sugar portion.

A compound or composition of matter is anticipated if the disclosure in a single reference places that compound or composition in possession of the public. *See In re Brown*, 329 F.2d 1006, 1011 (C.C.P.A. 1964). The reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures...." *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972). In other words, the reference must provide a certain degree of precision with respect to the specific compound claimed.

None of the saponins disclosed in the cited prior art references clearly and unequivocally discloses the claimed compounds. The compounds of Hedge, Bloor or Podolak do not have the unique rhamnose, rhamnose, glucose, glucuronic acid and glucose sugar series at the 3-position, as required by the compounds of the instant invention. In *Ex parte Westphal*, 223 U.S.P.Q. 630 (Bd. Pat. App. 1983), the claim was directed to a composition containing 3-methylthio-4-amino-6-*tert*-butyl-1,2,4-triazine-5-

one. A prior art patent disclosed a compound substituted at a particular position with alkyl having 1 to 8 carbon atoms, but did not specifically name the claimed *tert*-butyl radical. Thus, the board found that the reference did not provide the precision necessary for anticipation under § 102. Likewise, as Hedge, Bloor or Podolak do not teach the unique rhamnose, rhamnose, glucose, glucuronic acid and glucose sugar series at the 3-position of the saponin, the references do not provide the precision necessary for an anticipation rejection. Withdrawal of the rejection is therefore respectfully solicited.

Allowance of the claims and passage of the case to issue are respectfully solicited. Should the Examiner believe a discussion of this matter would be helpful, she is invited to telephone the undersigned at (312) 913-0001.

Respectfully submitted,

Date: 10/6/03

By: Stephen H. Docter  
Stephen H. Docter  
Reg. No. 44,659

McDonnell Boehnen Hulbert & Berghoff  
300 South Wacker Drive  
32<sup>nd</sup> Floor  
Chicago, Illinois 60606  
(312) 913-0001